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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,647	01/18/2001	Galina Dorozhkina	109289.00173	6089

28765 7590 02/24/2006

WINSTON & STRAWN LLP
1700 K STREET, N.W.
WASHINGTON, DC 20006

EXAMINER

MARKHAM, WESLEY D

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/761,647	Applicant(s) DOROZHKINA ET AL.	
	Examiner Wesley D. Markham	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,2,17,27-29 and 32-34.
 Claim(s) withdrawn from consideration: 18,19,21,22,25,31 and 38-50.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

WDM

ADVISORY ACTION

Response to Amendment

1. Acknowledgement is made of the after-final amendment filed by the applicant on 1/25/2006, in which the applicant proposed to amend Claims 1, 31, and 38 and cancel Claims 27 – 29 and 47 – 50. However, this amendment has not been entered because it raises new issues that would require further searching and/or consideration on the part of the examiner. Specifically, amended independent Claim 1 would require that the polymerizable substance comprise a first compound having at least one glycidyl ether functionality and a second compound having an epoxy group, as opposed to “glycidyl ether” and “epoxide”, thereby changing the scope of the claims. Also, the proposed amendments to Claim 31 (e.g., to depend the claim from Claim 1 and to change the term “filling composition” to “polymerizable substance”) alter the scope of the claim. Additionally, amending Claim 38 to depend from Claim 1 would change the scope of Claim 38 as well as all of the claims dependent therefrom. For the above reasons, the proposed amendment raises new issues that would require further searching and/or consideration on the part of the examiner, and the amendment has not been entered.

Response to Arguments

2. Applicant's arguments filed on 1/25/2006 have been fully considered but they are not persuasive.

3. Specifically, the applicant's arguments regarding the 35 U.S.C. 112, second paragraph, rejections are drawn to the claims as proposed in the after-final amendment of 1/25/2006. This amendment has not been entered for the reasons set forth above in paragraph 1; accordingly, the associated arguments are moot at this time.
4. Regarding the arguments drawn to the 35 U.S.C. 112, first paragraph (lack of written description), rejections, the arguments have been fully considered but are not convincing. Specifically, the applicant argues that page 8, line 21, to page 9, line 12, of the specification clearly describes the claimed genus, and the specification also provides several examples of compositions encompassed by the genus. The applicant concludes that such description and examples provides adequate support for the claimed invention. In response, the examiner has reviewed the specification as a whole, including the specific portion cited by the applicant. The paragraph bridging pages 7 and 8 of the specification discloses that the PC (presumably the polymerizable substance) components can include functional groups polymerizable by both cation and radical mechanisms. If both functional groups are incorporated in the same component, hybrid mechanism polymerization occurs (page 7, lines 24 – 27). As noted by the applicant and according to the specification, epoxy compounds are preferred in cation mechanism polymerization, while components containing unsaturated double bonds ((meth)acrylic type) are used in radical mechanism polymerization. Glycidyl ethers with unsaturated double bonds are used for hybrid mechanism polymerization (page 8, lines 6 – 7). The aforementioned section of the

specification does not disclose a combination of “epoxide” (cation mechanism) and “glycidyl ether”, as claimed by the applicant, much less that the polymerizable substance comprises glycidyl ether (0.1 – 85 wt%), epoxide (5 – 90 wt%), and a first alcohol (0 – 10 wt%), and wherein the solvent comprises a second alcohol that is different from the first alcohol. In fact, it appears that the specification indicates that the glycidyl ether compound must have unsaturated double bonds (not required by the claims) to function in the claimed invention. In addition, the applicant refers to several specific filling compositions in the originally disclosed examples (e.g., Examples 1 – 12) as support for the genus of filling compositions required by Claim 1. However, the originally disclosed filling compositions each contain very specific components in a very specific ratio and are not correlated at all by the originally filed specification. As such, the filling compositions originally described by the applicant only “map out” a minute portion of the presently claimed genus (i.e., they are not representative of the entire genus now claimed by the applicant). Therefore, the claims fail to comply with the written description requirement of 35 U.S.C. 112, first paragraph. Regarding the applicant’s comment that one skilled in the art would be aware that any compound having an epoxy group would function in the same way, this position is unsupported by any art or evidence of record. The genus of compounds containing one or more epoxy groups is infinite, and each and every one of these compounds certainly do not function in the same way, nor is there any indication that every single compound containing one or more epoxy group would function in the disclosed and/or claimed invention.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D. Markham whose telephone number is (571) 272-1422. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WDM

Wesley D Markham
Examiner
Art Unit 1762


TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER